

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1, 3, 5-11, 17-18, 21, 23, 25-31, and 37-38 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. §112, First Paragraph

On page 2 of the Office Action, the Examiner indicates that claims 5 and 25 are rejected “as failing to comply with the enablement requirement.” In particular, the Examiner states that the limitation “said peripheral device being inoperable without said image hub” is not defined in the Specification. Accordingly, Applicants herein amend claims 5 and 25 to delete the limitation “said peripheral device being inoperable without said image hub”. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s rejection is addressed, and respectfully request that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn so that claims 5 and 25 may issue in a timely manner.

35 U.S.C. § 102

On page 3 of the Office Action, the Examiner rejects claims 1-4, 6-13, 15, 18, 21-24, 26-33, 35, 38, and 41-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereafter Steinberg).

The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Steinberg fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended claims 1 and 21 which now recite “*an image hub configured to transfer said content information from said peripheral device to a data destination from which a system user selectively accesses said content information, said peripheral device having a transfer capability to transfer said content information only to said image hub,*” which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Steinberg basically teaches downloading “configuration data” from an external device to a camera device (see column 2, lines 18-47). In contrast, Applicants’ claimed invention is directed towards downloading “content information” from a camera device. Applicants therefore submit that the transfer direction in Steinberg is the opposite of the transfer direction in Applicants’ claimed invention, since Steinberg downloads to a camera, while Applicants download from a camera.

In addition, Applicants submit that Steinberg teaches downloading “configuration data” while Applicants’ specifically claim downloading “content information”. Applicants therefore submit that the type of information being downloaded in their invention is significantly different from the “configuration data” specified in Steinberg. Furthermore, Applicants submit that Steinberg nowhere discloses a “peripheral device having a transfer capability to transfer said content information only to said image hub,” as claimed by Applicants. For at least the foregoing reasons, Applicants submit that Steinberg fails to anticipate their claimed invention.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Steinberg and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Steinberg.

Regarding the Examiner’s rejection of dependent claims 2-4, 6-13, 15, 18, 22-24, 26-33, 35, 38, for at least the reasons that these claims are directly or

indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 6-13, 15, 18, 22-24, 26-33, 35, 38 so that these claims may issue in a timely manner.

Furthermore, in the present Response, Applicants herein amend dependent claims 3, 6-11, 18, 23, 26-31, and 38 to remove claim language that presented certain limitations of claims 3, 6-11, 18, 23, 26-31, and 38 in the alternative. Applicants submit that amended claims 3, 6-11, 18, 23, 26-31, and 38 now recite additional patentable subject matter that is not disclosed in the cited reference. Applicants therefore request the Examiner to reconsider amended claims 3, 6-11, 18, 23, 26-31, and 38 in light of these additional limitations.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Steinberg to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-4, 6-13, 15, 18, 21-24, 26-33, 35, 38, and 41-42, so that these claims may issue in a timely manner.

On page 5 of the Office Action, the Examiner rejects claims 1, 12-13, 15-21, 32-33, and 35-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent

No. 5,949,551 to Miller et al. (hereafter Miller). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Miller fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended claims 1 and 21 which now recite “*an image hub configured to transfer said content information from said peripheral device to a data destination from which a system user selectively accesses said content information, said peripheral device having a transfer capability to transfer said content information only to said image hub,*” which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Miller basically teaches transmitting multiple resolutions of image data from a scanner to a hub station (see column 2, line 57 to column 3, line 16). In contrast, Applicants disclose an “image hub” configured to download content information from a peripheral device, and then “transfer said content information from said peripheral device to a data destination from which a system user selectively accesses said content information.” Applicants submit that Miller fails to disclose a system user selectively accessing downloaded content information from a data destination.

In addition, Applicants submit that Miller teaches downloading only “digital images” while Applicants’ specifically claim downloading “content information”. Since “content information” is a significantly broader category than “digital images”, Applicants therefore submit that the type of information being downloaded in their invention is different from the “digital images” specified in Miller. Furthermore, Applicants submit that Miller nowhere discloses a “peripheral device having a transfer capability to transfer said content information only to said image hub,” as claimed by Applicants. For at least the foregoing reasons, Applicants submit that Miller fails to anticipate their claimed invention.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are further discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Miller and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Miller.

Regarding the Examiner’s rejection of dependent claims 12-13, 15-20, 32-33, and 35-40, for at least the reasons that these claims are directly or indirectly

dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 12-13, 15-20, 32-33, and 35-40 so that these claims may issue in a timely manner.

Furthermore, in the present Response, Applicants herein amend dependent claims 17 and 37 to remove claim language that presented certain limitations of claims 17 and 37 in the alternative. Applicants submit that amended claims 17 and 37 now recite additional patentable subject matter that is not disclosed in the cited reference. In particular, Applicants submit that Miller fails to disclose the data routing functions recited in amended claims 17 and 37. Applicants therefore request the Examiner to reconsider amended claims 17 and 37 in light of these additional limitations.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Miller to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1, 12-13, 15-21, 32-33, and 35-42, so that these claims may issue in a timely manner.

35 U.S.C. § 103

On page 8 of the Office Action, the Examiner rejects claims 5, 14, 25, and 34 under 35 U.S.C. § 103 as being unpatentable over Steinberg in view of U.S. Patent No. 6,580,460 to Takahashi et al. (hereafter Takahashi). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Steinberg according to the teachings of Takahashi would produce the claimed invention. Applicants submit that Steinberg in combination with Takahashi fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Steinberg nor Dodson contain teachings for combining the cited references to produce the

Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 5, 14, 25, and 34, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims, so that these claims may issue in a timely manner.

In addition, with regard to claims 5, 14, 25, and 34, the Examiner concedes that Steinberg "fails to state that the image hub provides a power source for recharging a power supply in the peripheral device." Applicants concur. The Examiner then points to Takahashi to purported remedy these defects. Takahashi generally teaches an imaging device that has the capacity to be powered by a printer device (see Abstract). However, Takahashi nowhere teaches "said image hub providing a sole power source for recharging a power supply in said peripheral device", as recited by Applicants in claims 5 and 25. Furthermore, Applicants submit that Takahashi also fails to disclose "said image hub also providing a sole transfer means for downloading said content information from said peripheral device", as recited by Applicants in claims 5 and 25.

Also with regard to the rejections of claims 5, 14, 25, and 34, the Examiner states that “[t]herefore, it would have been obvious to one skilled in the art [d]oing so would provide a means for preventing battery consumption” Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention may not act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 5, 14, 25, and 34 are not unpatentable under 35 U.S.C. § 103 over Steinberg in view of Takahashi, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5, 14, 25, and 34 under 35 U.S.C. § 103.

Examiner Interview Summary

On October 27, 2005, Applicants’ representative, Gregory Koerner, held an Examiner’s Interview with Examiner Kelly Jerabek to discuss various differences between the cited references and Applicants’ claimed invention. Applicants argued that neither Steinberg, Miller, nor Takahashi teach “an image hub configured to transfer said content information from said peripheral device to a

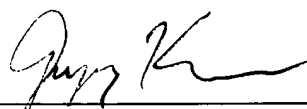
data destination from which a system user selectively accesses said content information”, as recited in independent claims 1 and 21. In addition, Applicants argued that the cited references nowhere discuss “said peripheral device having a transfer capability to transfer said content information only to said image hub, as claimed by Applicants in claims 1 and 21. Finally, Applicants argued that the cited references nowhere teach “said image hub providing a sole power source for recharging a power supply in said peripheral device” as recited in dependent claims 5 and 25.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §112, first paragraph, 35 U.S.C. §102(b), and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 10/27/05

By: 

Gregory J. Koerner, Reg. No. 38,519
Redwood Patent Law
1291 East Hillsdale Blvd., Suite 205
Foster City, CA 94404
Tel: (650) 358-4000